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REMARKS

This is a full and timely response to the non-final Official Action mailed April 5, 2005. Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

By the forgoing amendment, the specification and various claims have been amended. No claims are cancelled, and new claims 33-38 have been added. Claims 31 and 32 were withdrawn under a Restriction Requirement. Applicant elected claims 1-30 for immediate prosecution and hereby affirms that election. Thus, claims 1-30 and 33-38 are currently pending for further action.

35 U.S.C. § 101:

The outstanding Office Action rejected claims 1-6 as being directed to non-statutory subject matter and thus not in compliance with 35 U.S.C. § 101. Applicant respectfully disagrees. Claim 1, as originally presented, recited a specific electronic signal which is a manufacture within the meaning of § 101. However, to expedite prosecution of this application, claims 1-6 have been amended herein to recite a *system* for producing the desired electronic signal. Consequently, claims 1-6 are now directed to a system or machine and are clearly within the statutory bounds of § 101. Therefore, the rejection of claims 1-6 based on § 101 should be reconsidered and withdrawn.

Prior Art:

Claims 1-3, 7-10, 13-17, 20-26 and 28-30 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 5,986,690 to Hendricks ("Hendricks"). In the alternative, claims 1-12, 15, 16, 18-20, 23, 24 and 26-28 were rejected under 35 U.S.C. § 102(e) as

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anticipated by U.S. Patent No. 6,631,523 to Matthews, III et al. ("Matthews"). For at least the following reasons, these rejections are respectfully traversed.

Claim 1 recites:

A system for producing a television signal comprising:  
television programming; and  
an electronic publication,  
wherein said electronic publication comprises an electronic magazine that is independent of said television programming; and  
wherein said system automatically distributes said electronic magazine periodically to subscribers.

In contrast, Hendricks described a system by which electronic books are individually ordered and purchased, then distributed in connection with a video signal. (*See*, Hendricks, Fig. 14d). Hendricks does not teach or suggest a system for distributing an electronic magazine that is automatically distributed periodically to subscribers, as claimed.

On the other hand, Matthews merely teaches the well-known distribution of an electronic programming guide (EPG) in connection with a video signal. Matthews does not teach or suggest a system for producing a signal that includes an electronic magazine that is independent of the television programming also included in the signal, as claimed.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Neither Hendricks nor Matthews teaches or suggests all the features of claim 1. For at least these reasons, the rejection of claim 1 and its dependent claims based on Hendricks or Matthews should be reconsidered and withdrawn.

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Independent claim 7 recites:

A method of distributing an electronic publication, said method comprising:  
incorporating data for said electronic publication in a television signal along  
with television programming, wherein said electronic publication comprises an  
electronic magazine which is produced periodically and is independent of and does  
not refer to said television programming;  
broadcasting said television signal to users; and  
automatically receiving and storing said electronic magazine each time said  
magazine is offered.

As demonstrated above, Hendricks fails to teach or suggest a method of distributing  
an electronic magazine that is automatically received and stored each time it is offered.

Matthews fails to teach or suggest anything about distributing an electronic publication that is  
independent of the television programming with which it is distributed. For at least these  
reasons, the rejection of claim 7 and its dependent claims should be reconsidered and  
withdrawn.

Independent claim 15 recites:

A system for distributing an electronic publication, said system comprising:  
a television signal broadcasting headend, wherein a television signal broadcast  
from said headend comprises television programming and an electronic publication  
that is independent of said television programming; and  
a personal video recorder for extracting said electronic publication from said  
television signal for use by a user, wherein said personal video recorder stores selected  
television programming and said electronic publication.  
(emphasis added).

In contrast, neither Hendricks nor Matthews teach or suggest a personal video recorder  
that stores *both* selected television programming and an electronic publication as claimed.

For at least this reason, the rejection of claim 15 and its dependent claims should be  
reconsidered and withdrawn.

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Independent claim 23 recites;

A system for distributing an electronic publication, said system comprising:  
first means for broadcasting a television signal comprising both television programming and an electronic publication that is independent of said television programming; and  
second means for receiving said television signal and extracting said electronic publication from said television signal for use by a user,  
wherein said second means selectively outputs either said electronic publication or selected television programming to a common display means.  
(emphasis added).

In contrast, neither Hendricks nor Matthews teaches or suggests the claimed system in which television programming and an electronic publication that is independent of that television programming is transmitted by a first means and then available through a second means on a common display means. For at least this reason, the rejection of claim 23 and its dependent claims should be reconsidered and withdrawn.

Various dependent claims also recite subject matter that is not taught or suggested by either of the prior art references cited. For example:

Claim 8 recites "receiving said television signal; and storing said electronic publication and selected television programming on a common digital data storage device." Claims 16 and 24 recites similar subject matter. Neither Hendricks nor Matthews teach or suggest this subject matter. Consequently, the rejection of these claims should be reconsidered and withdrawn.

Claim 9 recites "providing an interactive menu as part of said electronic publication for skipping to different parts of the publication." New claims 24, 37 and 38 recite similar subject matter. Neither Hendricks nor Matthews teach or suggest this subject matter. Consequently, the rejection of these claims should be reconsidered and withdrawn.

Claim 10 recites "controlling access and output of either said selected television programming or said electronic publication to a common video monitor with a user input

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device.” Claim 20 recites similar subject matter. Neither Hendricks nor Matthews teach or suggest this subject matter. Consequently, the rejection of these claims should be reconsidered and withdrawn.

New claim 35 recites “wherein said system transmits said electronic magazine at night or early in the morning when demands on the system for are minimal.” Claim 26 recites similar subject matter. Neither Hendricks nor Matthews teach or suggest this subject matter. Consequently, the rejection of these claims should be reconsidered and withdrawn.

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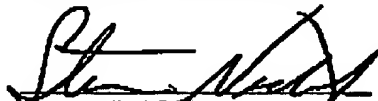
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Conclusion:

The newly added claims, that are not specifically discussed above, are thought to be patentable over the prior art of record for at least the same reasons given above with respect to the original independent claims. Therefore, examination and allowance of the newly added claims is respectfully requested.

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If any fees are owed in connection with this paper which have not been elsewhere authorized, authorization is hereby given to charge those fees to Deposit Account 18-0013 in the name of Rader, Fishman & Grauer PLLC. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

  
Steven L. Nichols  
Registration No. 40,326

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Steven L. Nichols, Esq.  
Managing Partner, Utah Office  
**Rader Fishman & Grauer PLLC**  
River Park Corporate Center One  
10653 S. River Front Parkway, Suite 150  
South Jordan, Utah 84095  
(801) 572-8066  
(801) 572-7666 (fax)

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Rebecca R. Schow